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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/966,540
Filing Date: September 27, 2001
Appellant(s): OGINO, HIROSHI

Sheryl Sue Holloway, Reg. No. 37,850
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 March 2006 appealing from the Office action mailed 06 February 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,446,871	BUCKLEY et al.	9-2002
6,163,771	WALKER et al.	12-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Applicant is of the opinion that the prior art does not anticipate or render obvious Applicant's claims because the prior art does not teach Applicant's "privacy server" and does not perform electronic transactions "without providing an identification of a user" of a transaction device. The Examiner respectfully disagrees. In Applicant's analysis of the Buckley et al. system, Applicant correctly notes that

> ... Buckley is silent on whether the communication with connection server, news server and/or portal server provides or withholds the user's identification. Thus, the connection, news and/or portal servers supply the requested (Remarks, 11-16-04, page 9, lines 17-19)

Therefore, the Examiner and the Applicant are in accordance, as Buckley et al. do not teach, disclose nor suggest revealing a user identification during a transaction (column/line 5/62-6/13). Regarding a "privacy server", the Applicant has not provided a specific definition for such a device and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Hence according to Applicant's claims for a server to be a "privacy server", a server need only, withhold user identification during a

transaction (e.g. claims 1 and 7), couple to a transaction device for authorizing transactions (e.g. claim 18) couple or comprise a financial institution (e.g. claims 22 and 23), comprise a secure database of transaction device information and user information, said database accessed for authorizing a transaction (e.g. claim 24), and/or perform financial transactions associated with the transaction (e.g. claim 25). As these features are clearly taught by Buckley et al., Walker et al. and Peckover (Buckley et al., figures 4, 5, 8 and 9, column 9, lines 8-64; Walker et al., figures 3A, 5, 9A-B, 11A and 13; Peckover, abstract, figures 1 and 4A), Applicant's claim to a "privacy server" cannot distinguish Applicant's claims from the clear teachings of the prior art.

In response to the 112 Second rejection of claim 7, Applicant states that Applicant is claiming a privacy system that interacts with the claimed electronic transaction device (Remarks, 11-16-04, page 8), however, the preamble of claim 7 is clearly directed to an "electronic transaction device". Therefore, the Examiner maintains the 112 Second rejection because Applicant's claims are not precise, clear, correct, and unambiguous (*In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Therefore, the Examiner maintains the rejection.

Claim Rejections - 35 USC § 112

Claims 7-13 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites, a "privacy system comprising a secure mechanism..." However, claim 7 is dedicated to a transaction device that does not comprise or contain a "privacy system".

Claims 8-13 are also rejected as they depend from claim 7.

Claim 15 recites the limitation "the transaction privacy clearinghouse" in line 2. Claims 16 and 17 recite "the electronic commerce transaction" in line 1. There is insufficient antecedent basis for these limitations in the claims.

Claims 16 and 17 are also rejected as they depend from claim 15.

Claim Rejections - 35 USC § 102

Claims 1-4, 6-11, 13, 14 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Buckley et al., U.S. Patent No. 6,446,871.

As per claims 1-4, 6-11 and 13 the MPEP (2144) is clear,

> while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of *structure* rather than function alone (italics added)

Therefore (claims 1-4 and 6), as Buckley et al. clearly disclose a transaction device (figure 3E; column/line 4/48-5/8) comprising a sensor module (e.g. barcode reader) (column 5, lines 9-37; column 6, lines 12-19) and a communication module (figures 4 and 5), that are configured to receive (e.g. product information) (figure 9; column 8, lines 27-44) and transmit data to servers (figures 4, 5, 8 and 9; column 9, lines 8-64 or inherently DNS, caching, and/or proxy servers), respectively. The device also receives data from servers based on the product identification (figures 4, 5, 8 and 9; column 10, lines 14-65), makes requests to purchase a product without providing an identifier of the user (column/line 5/62-6/13), stores retrieved product data (figure 9; column 10, lines 7-39; column/line 10/55-11/26).

As per claims 7-11, and 13 Buckley et al. teach a transaction device comprising a sensor module (for reading product information from a product tag) (figures 1-3E), wireless module (figures 1-3E; column 4, line 55-61), a communication module (abstract; figures 4 and 5), and a display module for displaying received information (figure 9). Buckley et al. also teach an electronic transaction device that can purchase products from a vendor through a secure mechanism using the wireless and communication module (column/line 5/62-6/13; column 9, lines 7-25).

As per claims 14 and 26, Buckley et al. teach receiving at a transaction device, a signal based on a product tag associated with a product (figures 4, 5, 8

and 9), transmitting the product tag to a product server through a privacy server (figure 4) indicating a request of product information based on the product tag without providing an identity of the user (figures 4 and 5) and receiving product information from the product server (figure 9).

Claim Rejections - 35 USC § 103

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Ausems et al., U.S. Patent No. 6,434,403.

As per claims 5 and 12, Buckley et al. teach a transaction device comprising a data acquisition device and a computer for transmitting acquired data to a site on the internet (figures 4, 5, 8 and 9). However, Buckley et al. do not specifically recite a privacy card, digital wallet, or a privacy card configured to be coupled to a wallet. Ausems et al. teach a portable computer such as a privacy card (column 6, lines 53-59) for transmitting data over the internet (figure 2; column/line 5/65-6/8; column 7, lines 9-20; column/line 7/62-8/6). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al. into the portable device of Ausems et al. ('871, column 11, lines 27-37) in order allow users (e.g. traveling salesman-'871, column 5, lines 62-67) to conduct business while on route to a destination.

Claims 15, 17, 18, 20-25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Walker et al., U.S. Patent No. 6,163,771.

As per claims 15, 17, 18, 20-25, 27 and 29, Buckley et al. teach a transaction device for making purchases over the internet from a vendor (column/line 5/62-6/13; column 9, lines 8-25) using a transaction device and a server. However, Buckley et al. do not specifically recite using device identifiers. Walker et al. teach a secure method for making purchases over the internet using a device (privacy card, or digital wallet or privacy card coupled to a digital wallet-'771, abstract, figures 1 and 2) identifier and a user account to communicate with a privacy server comprising a database for authorizing a transaction, and wherein the user identity is unknown to a seller (figures 3A-B, 8 and 9B; column/line 6/60-7/20; column/line 7/45-8/65). Walker et al. also teach a privacy server coupled to, or comprising a financial institution (figure 4). Therefore, it would have been obvious to combine the teachings of Buckley et al. and Walker et al. in order to protect a user from credit card theft ('771, column 2, lines 35-61).

Claims 16, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 and Walker et

al., U.S. Patent No. 6,163,771 as applied to claim 15 above, and in further view of Peckover, U.S. Patent No. 6,119,101.

As per claims 16, 19, and 28 Buckley et al. teach purchases over the internet using product tag data (figures 4, 5, 8 and 9; column/line 5/62-6/13; column 9, lines 8-25). Walker et al. teach secure transaction over the internet using device identifiers (abstract). However, neither Buckley et al. nor Walker et al. teach receiving coupons. To one of ordinary skill a coupon is a form of advertisement. Peckover teaches a system where users, whose specific identity is unknown to the vendor (figure 4A), make queries regarding desired products and or information (column 15, lines 10-63; column/line 27/51-29/57) are able to receive digital advertisements and other messages from sellers through a third party device (e.g. privacy server) (abstract; figure 1). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al., Walker et al. and Peckover in order to allow vendors to target specific advertisements to desired users ('101, abstract; column/line 35/63-37/40)

(10) Response to Argument

112 Rejection-Claims 7-13

The Examiner withdraws the 112 second paragraph rejection to claims 15-17.

Claim 7 is directed to a transaction device comprising a sensor module and a wireless module. In characterizing Appellant's device, however, Appellant describes the device as a "privacy system that interacts with the claimed electronic transaction device" (Remarks, 11-16-04, page 8). However, this description of the transaction device clearly contradicts the device as it appears in Appellant's Specification (Specification, figure 5 and page/paragraphs 11/39-13/44). Therefore, the claim 7 is indefinite because Appellant's claims are not precise, clear, correct, and unambiguous (*In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

102 Rejection-Claims 1-4, 6-11, 13, 14 and 26

Initially, the Examiner would like to point that the limitations of claim 1 are expressed using the term "configured". According to the MPEP (2114) while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of *structure* rather than function alone (italics added).

Buckley et al. explicitly teach the structure of Appellant's transaction device. Specifically, Buckley et al. teach a transaction device ('871, figure 3A) comprising a sensor module (i.e. pen) ('871, figure 2A) for scanning product identifiers and a communication module (i.e. data well and computer)('871, figures 3A-C and 4) for transmitting the identifier to the internet ('871, figures 5 and 9). It has been held that recitation of a new intended use for an old product does not make a claim to that old product patentable (*In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). It has also been held that the grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition (*In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 162(CCPA 1957)). Therefore, as Buckley et al. teach contains all structural limitations recited in application claims (*In re Schreiber*, 44 USPQ2d 1429 (CCPA 1997)), Buckley et al. sufficiently anticipates Appellant's claimed transaction device.

Appellant is of the opinion that the prior art of Buckley et al. does not anticipate Appellant's representative claim 1. Specifically, Appellant asserts that Buckley et al. do

not teach obtaining product information from the product server without providing an identification of a user of the transaction device. Buckley et al. disclose an interactive data transfer system comprising a pen, a data well, and a remote computer ('871, abstract; figures 2A, 3A-C and 4). Specifically, Buckley et al. teach a user scanning a barcode with a pen and storing the scanned barcode in pen memory ('871, column 6, lines 13-18). When the pen is ready to send the scanned barcodes over the internet ('871, figure 4), the pen interfaces with a data well and downloads the barcodes to the well ('871; figures 3A-E; column 6, lines 58-67) which sends the barcodes to a computer ('871, figure 3A) for transfer to a remote internet server ('871, figure 4). For example, Buckley et al. apply teach scanning a product identifier (e.g. encyclopedia, newspaper, or item barcode) to obtain product information (e.g. encyclopedia information, ads, catalog website for placing an order for an item) ('871, figures 4, 5, and 9; column 9, lines 8-25; column 11, lines 45-50; column 12, lines 37-51). In each instance, the information conveyed from the pen to the data well to the computer to the internet server is the only barcode, hence Buckley et al. explicitly teach obtaining product information from a product server through a privacy server ('871, figure 5) without providing an identification of a user of the transaction device (i.e. pen and data well). Switching roles with the Appellant for a second, the Examiner asks, *where do Buckley et al. explicitly teach sending an identification of a user of the pen?* If such a teaching would be found in Buckley et al. then Appellant surely would have pointed it out. However, Appellant's Appeal Brief is curiously silent such a recitation.

103 Rejection-Claims 5 and 12

Appellant identifies claim 5 as the representative claim.

Appellant's is of the opinion that the combined prior art of Buckley et al. and Ausems et al. do not teach obtaining product information from the product server without providing an identification of a user of the transaction device. The Examiner respectfully disagrees. Buckley et al. disclose an interactive data transfer system comprising a pen, a data well, and a remote computer ('871, abstract; figures 2A, 3A-C and 4). More specifically, Buckley et al. teach scanning a product identifier (e.g. encyclopedia, newspaper, or item barcode) to obtain product information (e.g. encyclopedia information, ads, catalog website for placing an order for an item) ('871, figures 4, 5, and 9; column 9, lines 8-25; column 11, lines 45-50; column 12, lines 37-51). In each instance, the information conveyed from the pen to the data well to the computer to the internet server is the only barcode, hence Buckley et al. explicitly teach obtaining product information from a product server through a privacy server ('871, figure 5) without providing an identification of a user of the transaction device (i.e. pen and data well).

Claims 15, 17, 18, 20-25, 27, and 29

Appellant identifies claim 18 as the representative claim.

Appellant is of the opinion that the combined prior art of Buckley et al. and Walker et al. do not teach concealing the identity of the user. The Examiner respectfully disagrees.

Initially, the Examiner would like point out Appellant relies on "intended use" language such as "configured to" describe the claim. Further, Appellant's claim 18 also recite "*when* a transaction related to the product *is to be* performed" (emphasis added). However, In re Collier (158 USPQ 266 (CCPA 1968)) is clear, intended uses based on future acts that are not necessarily performed are not structural limitations and therefore do not distinguish the claim from the prior art. More specifically, the limitations of claim 18 subsequent to a potential coupling of the personal transaction device and the privacy server do not further limit the claim. Nonetheless, Walker et al. teach a personal transaction device comprising an identifier such as a cryptographic key ('771, abstract) that the device uses to generate a single-use credit card number ('771, abstract; column 6, lines 61-64). Walker et al. apply their system to offline or point of sale transactions ('771, column 6, lines 5-14). When a user is ready to purchase goods and services from a merchant, the user is authenticated at the personal transaction device ('771, figure 1) using a PIN, for example. If the device authenticates the user, the device generates or produces a single-use credit card number ('771, figure 10) and transmits the single-use credit number to the merchant device the merchant device in turn transmits the number to a privacy server (i.e. credit card issuer) ('771, column 6, lines 5-13; column 8, lines 30-35) wherein the server authenticates the transaction based on the device identifier

and user account information ('771, abstract; figures 5 and 6; column 7, lines 27-32; column 8, lines 40-55). Walker et al. also teach not revealing the identity of the user to the merchant ('771, figure 3B). For example, Walker et al. specifically recite transmitting only the single-use credit card number ('771, column 6, lines 4-29) and in an alternative embodiment using encoding the name of the user instead of the actual credit card account number for generating the single-use credit card number ('771, column 11, lines 8-18). In either case, however, the account number or the user's name is encrypted ('771, abstract; figure 3B) and can only be decrypted at the credit card issuer (i.e. privacy server) ('771, abstract), hence the user's identity is never revealed to the merchant. Therefore, the prior art singly, and in combination ('871, figures 4, 5, and 9, column 9, lines 8-25, column 11, lines 45-50, column 12, lines 37-51; '771, abstract, column 6, lines 4-29; column 8, lines 30-35) teaches the claimed limitation of "wherein an identity of the user is not provided to the vendor".

Claims 16, 19, and 28

Peckover teaches a system where users, whose specific identity

is unknown to the vendor ('101, figure 4A), make queries regarding desired products and or information ('101', column 15, lines 10-63; column/line 27/51-29/57) are able to receive digital advertisements and other messages from sellers through a third party device (e.g. privacy server) ('101, abstract; figure 1). Therefore, the prior art singly, and in combination ('871, figures 4, 5, and 9, column 9, lines 8-25, column 11, lines 45-50, column 12, lines 37-51; '771, abstract, column 6, lines 4-29; column 8, lines 30-35; '101, figure 4A, column 15, lines 10-63, column/line 27/51-29/57) teaches the claimed limitation of "wherein an identity of the user is not provided to the vendor".

Conclusion

Appellant's arguments are not persuasive in that they are based on a reading of the prior art that is not supported, and in fact repugnant, to the teachings of Buckley et al., Walker et al. and Peckover et al. and that Appellant's claims continue to recite intended use language.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Calvin Loyd Hewitt II

Conferees:

James P. Trammell

Hyung Sough